

### **REMARKS**

The applicant respectfully requests reconsideration in view of the amendment and the following remarks. The applicant has amended claim 1 in order to place the claim in better form. The claim was not amended to overcome the prior art. The applicant has amended claims 2, 5 and 9 in order to overcome the 35 USC 112 rejection. Support for amended claims 2 and 5 can be found in the specification at page 5, lines 16-20. Support for newly amended claims 7 and 8 can be found in the specification. Support for newly added claim 16 can be found in the original claim 1 and in the specification at page 3, lines 25-27.

Claims 2, 5, 7, 8 and 9 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surmatis (US 3,932,485 A) ("Surmatis"), in view of Schleich et al. (US 4,254,281 A) ("Schliech"). Claims 1, 5, and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/582,912 in view of Surmatis. The applicant respectfully traverses these rejections.

#### **§ 112 Rejection**

Claims 2, 5, 7, 8 and 9 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant believes that the claims as amended are in compliance with 35 U.S.C. § 112, second paragraph. For the above reasons, this rejection should be withdrawn.

#### **§ 103 Rejection**

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surmatis in view of Schleich. The German equivalent of Schleich is cited at page 1 of the specification. The applicant respectfully disagrees to the Examiner's opinion that the mere combination of the two documents, Surmatis and Schleich would lead a person of ordinary skill in the art to the present invention. Especially, with regard to the complex solvent mixture claimed within the frame of the present invention the applicant is not able to follow the Examiners argumentation. Neither of

these references teaches or suggests solvent mixtures. In contrast, only pure solvents are used that are either “conventional inert organic solvents” (Surmatis) or water (Schleich).

Surmatis requires the use of an inert organic solvent. In fact, Surmatis only discloses the use of an inert organic solvent. Surmatis states at col. 4, line 59- col. 5, line 3:

**This reaction takes place in an inert organic solvent medium.** Any of the **inert organic solvents** conventionally utilized in the Wittig synthesis can be utilized in the reaction medium. Among the preferred conventional inert organic solvents which form the reaction medium are the solvents disclosed in U.S. Pat. No. 3,441,623, column 4, lines 60 to 62, such as the lower alkanols, e.g., methanol and ethanol, the aromatic hydrocarbons, e.g., benzene and toluene, the chlorinated hydrocarbons, e.g., methylene chloride and chloroform, and the ethers, e.g., tetrahydrofuran, dioxane and diethyl ether.

The term organic solvents would exclude water by the terms “inert” and “organic”. Furthermore, the applicant does not believe that that Surmatis teaches or suggests mixtures of the claimed organic solvents, let alone the applicant’s specifically claimed solvent mixture consisting of

- **60 to 80% by weight methanol,**
- **10 to 20% by weight water** and
- **10 to 20% by weight aliphatic, cyclic or aromatic hydrocarbons having 5 to 8 carbon atoms.**

The applicant claims a specific solvent mixture with three different solvents in a specific amount.

Schleich does not teach or suggest mixtures of solvents but teaches the exclusive use of water as solvent.

Therefore, from neither side the complex solvent mixture of the present invention consisting of not less than three solvents can be regarded as obvious. In contrast the combination

of both documents suggests choosing between pure inert organic solvents or water and is thus leading away from the present invention.

The applicant respectfully disagree that present claim 3 is obvious in view of Surmatis. According to Surmatis the reaction temperature is not critical (col. 5, lines 4-8). But the experiments of the present invention have clearly demonstrated that the reaction at elevated temperature is advantageous when compared to a temperature that is closer to the range suggested by Surmatis et al. (present invention, p. 6-7, examples 2-5). For the above reasons, this rejection should be withdrawn.

**Double Patenting Rejection**

Claims 1, 5, and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/582,912 in view of Surmatis.

In response, Applicants have filed herewith a Terminal Disclaimer. Accordingly, Applicants respectfully request that the double-patenting rejection be withdrawn.

The filing of a Terminal Disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. The "filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection. For the above reasons, this rejection should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant has paid a one-month extension of time fee. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00257-US from which the undersigned is authorized to draw.

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Respectfully submitted,

Electronic signature: /Ashley I. Pezzner/  
Ashley I. Pezzner  
Registration No.: 35,646  
CONNOLLY BOVE LODGE & HUTZ LLP  
1007 North Orange Street  
P. O. Box 2207  
Wilmington, Delaware 19899-2207  
(302) 658-9141  
(302) 658-5614 (Fax)  
Attorney for Applicant

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